REMARKS

Claims 1, 11, and 14 have been amended for clarification of antecedent basis. No new matter is added with these amendments, which are supported in the specification as originally filed. Claims 1 - 17 remain in the application.

1. Rejection Under 35 U.S.C. §103(a)

Page 2 of the Office Action dated July 13, 2004 (hereinafter, "the Office Action") states that Claims 1, 5, 9, 11 - 12, and 14 - 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 6,587,835 to Treyz in view of U. S. Patent 6,415,291 to Bouve. Page 6 of the Office Action states that Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Treyz and Bouve in view of U. S. Patent Publication US 2002/0091758 to Singh. Page 8 of the Office Action states that Claims 3 - 4, 6 - 7, 10, 13, and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable the combination of Treyz and Bouve in view of U. S. Patent 6,386,450 to Ogasawara. Page 12 of the Office Action states that Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable the combination of Treyz and Bouve in view of U. S. Patent 5,155,679 to Jain. Page 14 of the Office Action states that Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable the combination of Treyz and Bouve in view of U. S. Patent Publication US 2002/0038307 to Obradovic. These rejections are respectfully traversed.

The final limitation of Applicants' independent Claims 1, 11, and 14 specifies that a shopping path is "programmatically comput[ed] such that the user can use the shopping path to

travel among the locations of at least two selected ones of [a plurality of] merchants" (emphasis added). Page 3, lines 2 - 6 of the Office Action admits that Treyz does not teach this limitation. Page 3, line 13 - p. 4, line 2 then states that Bouve teaches this limitation in his Abstract, col. 5 lines 5 - 19, and Fig. 2. Applicants respectfully disagree with this characterization of Bouve, as will now be discussed in more detail.

Page 3, line 16 - p. 4, line 2 indicates that the map shown in Bouve's Fig. 2 corresponds to this limitation of Applicants' independent claims. Showing a map with highlighted locations, as in Bouve's Fig. 2, is quite different from programmatically computing a path between those locations. Although the sentence beginning on p. 3, line 19 of the Office Action states that the path "is clearly noted by the streets to follow", Applicants respectfully submit that this is reading more into Bouve than is taught therein. Bouve's map is left to the human user to decipher, and the human user is left to manually determine a path between the 2 locations shown in Bouve's Fig. 2. This is clearly distinct from a programmatic computation of the path, as in Applicants' claim language.

Suppose, for example, that a user of Applicants' invention needs to buy groceries, drop off her dry cleaning, and buy automotive parts (p. 14, lines 6 - 7) somewhere along a route between her office and her home (p. 17, lines 3 - 4). It may happen that this route spans a considerable number of miles. By way of example only, suppose the user's office and home are 30 miles apart. Using Bouve's approach of providing a map that encompasses the entire 30 miles, with 3 shopping/service locations pinpointed thereon, is unlikely to be very helpful in assisting the

user; as noted above, the user of Bouve's invention must still manually compute a path between the locations. And, if there are multiple candidate locations for buying groceries, having items dry cleaned, and/or buying automotive parts, Bouve's map will simply comprise scattered dots that the user must try to manually decipher and connect into a path. Applicants' claimed invention, by contrast, programmatically computes a path between the locations the user needs to visit (i.e., a path for "travel[ing] among the locations" of selected merchants).

While the example provided above is in terms of locations spread over a number of miles, the distinctions demonstrated by that example hold true without regard to the scale or duration of the shopping path. For example, a programmatically computed shopping path within the boundaries of a shopping mall (see p. 10, lines 8 - 10 of Applicants' specification) is still distinct from a printed map of the shopping mall with stores highlighted thereon in which the user is left to manually determine a path among the stores (as in Bouve).

In summary, Applicants respectfully submit that programmatically computing a path (as in Applicants' independent claims) is patentably distinct from providing the user with a map from which the user may attempt to manually determine a path (as in Bouve).

Section 706.02(j) of the MPEP, "Contents of a 35 U.S.C. 103 Rejection", states the requirements for establishing a *prima facie* case of obviousness under this statute, noting that three criteria must be met. These criteria are (1) a suggestion or motivation, found either in the references or in the knowledge generally available, to modify or combine the references; (2) a

reasonable expectation of success; and (3) the combination must teach all the claim limitations. This text goes on to state that "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.". The three requirements for establishing a *prima facie* case of obviousness are also stated in MPEP §2142, "Legal Concept of *Prima Facie* Obviousness", and MPEP §2143, "Basic Requirements of a *Prima Facie* Case of Obviousness".

Because the citation provided in the Office Action for the final limitation of Applicants' independent Claims 1, 11, and 14 fails to teach "programmatically computing ...", a *prima facie* case of obviousness has not been made out with regard to these claims, and without more, these claims are deemed patentable. See ***In re Oetiker***, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

> If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.

Having failed to establish that the independent claims are obvious, the rejection of the dependent claims fails as well. See §2143.03 of the MPEP, which states that

> If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.

In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, dependent Claims 2 - 9, 11 - 13, and 15 - 17 are deemed nonobvious and therefore patentable over the references.

Applicants respectfully disagree with other aspects of the analysis of their claimed

invention. For example, p. 6, lines 6 - 7 of the Office Action state that the combination of Treyz and Bouve teaches "the number of blocks to the next computer products store". However, neither of these references has any text whatsoever discussing the "number of blocks" to anything. In addition, p. 16, line 11 - p. 17, line 18 of the Office Action discusses admissions pertaining to the Examiner's official notice. Applicants respectfully submit that because a *prima facie* case of obviousness has not been made out with regard to their independent claims, as demonstrated above, the burden for refuting the Examiner's official notice has not passed to Applicants. Thus, Applicants need not put forth arguments on this point, and failure to do so does not constitute an admission by Applicants.

In view of the above, Applicants respectfully request that the Examiner withdraw the §103 rejection of all claims.

II. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all claims at an early date.

Respectfully submitted,

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